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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,833	12/03/2001	Jouko Suhonen	21499/0050	4499

7590

11/18/2003

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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

8

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

Office Action Summary	Application No. 09/913,833	Applicant(s) SUHONEN, JOUKO	
	Examiner John J. Wilson	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

The election is modified below:

The subspecies are eliminated as unnecessary and claim 17 belongs to and is included as Species II.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species I including a pre-filled container as shown, for example, in Fig. 1;

Species II including a container with a filling cartridge as shown in Fig. 12;

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Species I: Claims 2-10 and 12-16.

Species II: Claims 17-22.

The following claim(s) are generic: 1 and 11.

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Applicant's election with traverse of the election requirement in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the subspecies should be considered with the Species. This is not found persuasive because it is moot in view of the above modification to the election requirement to eliminate the subspecies requirement in view of the indicated allowability of a generic claim from which the subspecies claims depend. Note claim 2 was generic to the subspecies claims.

The requirement is still deemed proper and is therefore made FINAL.

An action on the merits of claims 1-16 follows. Claims 17-22 stand withdrawn from further consideration as being drawn to a non-elected species.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Keller (5330357). A shows a closed flexible container 53, Figs. 15 and 16, and a tip 59. The shown structure is inherently capable of being filled with a restoration material and is inherently capable of being punched with a hole. The intended use of the shown structure for filling and reinforcing an internal tunnel in a tooth is merely use and is given no patentable weight.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Suhonen (6007334). Suhonen shows a device for filling teeth having a closed elongated flexible container 10 and tip 12. The shown structure is inherently capable of being filled with a restoration material and is inherently capable of being punched with a hole.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Cheetham (5816805). Cheetham shows a device 10 for filling teeth having a closed elongated container and tip 28, column 4, line 34. After mixing, Cheetham teaches that the restorative material is pre-filled, that is before use, in the container. The shown tip structure is held to inherently be insertable in an interdental space because of the wide variety of interdental spaces that exist.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suhonen (6007334). Suhonen show the structure as described above, however, does not specifically state that the container is opaque. That nylon may be opaque is well known, and therefore, would have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-10 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 states that the container is pre-filled, however, the claim form which it depends claims "or fillable", therefore, it is unclear if the container is pre-filled or not. For purposes of this Office Action, it is assumed that claim 2 is directed only to the pre-filled embodiment.

Allowable Subject Matter

Claims 2-10 and 12-16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings

The drawings filed on December 3, 2001 have been found to be acceptable by the examiner.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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Specification

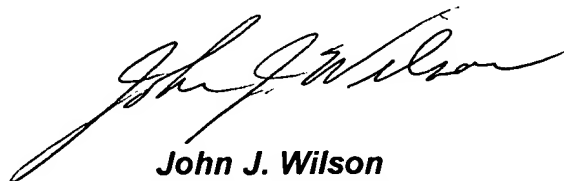
This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Headings for the specification are suggested.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taylor (404745) shows a flexible container 6. Axelsson (4411623) shows an interdental device. Cruttenden (1341736) shows a container for restorative material.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.



**John J. Wilson
Primary Examiner
Art Unit 3732**

jjw

November 7, 2003

Fax (703) 308-2708

Work Schedule: Monday through Friday, Flex Time